

result that “residues” of the hydroxyalkyl acrylates (lacking the hydroxy group) form the and substituents of the phosphazene compound of formula (I) (see column 3, lines 12-15), and (2) as reactants with isocyanate compounds to produce polyurethane acrylates, a reaction which also proceeds through the pendant hydroxyl group of the acrylate monomer. Accordingly, in neither of these two reactions is the result a polymer or copolymer which would have free hydroxy groups.

Mori et al also mention alkylhydroxy acrylates as “photopolymerizable” monomers at column 4, lines 14-28. Also see column 2, lines 38-44. However, this teaching of monomers is not considered relevant to applicants’ recitation of a heat-reactive resin defined as an acrylic copolymer of different first and second monomers, at least one of which is an acrylate or methacrylate and the second has a hydroxyl group.

The interview was successful in reaching agreement to the extent that the Examiner acknowledged that the outstanding rejection takes, out of context, mention of a hydroxyalkyl acrylate monomer in Mori et al. The Examiner further indicated that the rejection would be withdrawn if the undersigned could explain why the claim language “being formed by radical polymerization” is not “new matter.” In response, the undersigned noted that such an explanation had already been made of record, as the second full paragraph at page 5 of applicants’ “Response Accompanying RCE” filed March 29, 2005.

## 2. Interpretation of Japanese Kokai 63-132097.

This issue is summarized as item 1 of the attached memorandum. Briefly, as was submitted during the interview, the first full paragraph at page 6 of the “FLS” translation furnished by the Examiner with the most recent office action, serves to clarify

the translation, to the extent that it needs clarification, in a manner supporting applicants' interpretation. The "FLS" translation clearly describes a mixture of (1) prepolymers or oligomers", (2) "the afore-mentioned monomers", and/or (3) polythiols. In response, the Examiner referred to the first five lines at page 2 of a partial translation of the same Kokai document submitted with applicants' response of February 3, 2004. That partial translation describes the same "mixture" of components (1), (2) and/or (3). These teachings establish that the acrylamide mentioned as a monomer in the Japanese document, is mentioned in the context of a monomer in admixture with the prepolymer or oligomer. Nowhere do either of the translations of record mention acrylamide as a monomeric component of prepolymer or oligomer as suggested by the Examiner in the most recent office action.

In response to the foregoing explanation, the Examiner noted that applicants' claims are sufficiently broad to include a monomer in the curable adhesive layer recited by applicants' claim 1. In this regard, the Examiner is correct. However, the Examiner is reminded that his rejection relies upon the Japanese reference as disclosing a heat-reactive copolymer which the Examiner purports to find in the Japanese document in the form of a copolymer of acrylamide. If, as the Examiner seemed willing to admit, the Japanese document discloses acrylamide only as a monomer in the curable composition, the alleged teaching of the Japanese document upon which the Examiner relies does not exist and the rejection must be withdrawn for this reason also. Mori et al does not teach anything regarding an adhesive layer and, in this respect, the purported (nonexistent) teaching of the Japanese document is essential to the Examiner's theory of obviousness.

3. The Propriety of the Reference Combination.

Although this point was not covered during the telephone interview, applicants wish to reemphasize that, even if the teachings essential to the Examiner's *prima facie* case of obviousness could be found in the respective documents, the combination of such teachings in the manner adopted by the Examiner would be improper for several reasons.

Firstly, there would be no recognition or suggestion in the Japanese document that the allegedly disclosed acrylamide copolymer would be heat-reactive or that it should be considered an equivalent of a hydroxyl containing copolymer, allegedly disclosed by Mori et al. In this regard, the Examiner relies upon the teachings of applicants' specification as establishing such an equivalence. However, motivation or reason for combining the references must be found in the prior art. To use applicants' specification as furnishing motivation for combining reference teachings is legally erroneous. "The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, not in applicants' disclosure," quoting from MPEP §2143.

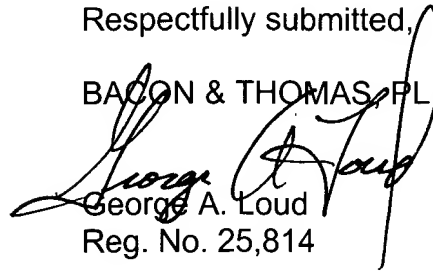
Secondly, assuming that the adhesive layer of the Japanese document has the same composition as that used to form the "cured resin layer", a point repeatedly emphasized by the Examiner, it would not logically follow that the teachings of Mori et al, directed to improving the hardness, etc. of a "protective film", would apply to the adhesive layer of the Japanese document. The characteristics of the "protective film", as disclosed by Mori et al, are not relevant to an adhesive layer.

For the foregoing reasons, it is respectfully submitted that the outstanding

rejection should be withdrawn and that the pending claims should be allowed.

Respectfully submitted,

BACON & THOMAS, PLLC

A handwritten signature in black ink, appearing to read "George A. Loud", is written over the printed name and registration number.

George A. Loud

Reg. No. 25,814

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BACON & THOMAS, PLLC  
625 Slaters Lane - Fourth Floor  
Alexandria, VA 22314

(703) 683-0500